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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92040559
Party	Defendant INTRADO, INC. 2325 LAKEVIEW PARKWAY SUITE 700 ALPHARETTA, GA 30004
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Date	10/01/2004
Attachments	Intrado Boggs Answer Brief.pdf (12 pages)

United States Patent and Trademark Office Trademark Trial and Appeal Board

Our Ref: 1092-029.001

A.J. Boggs & Company

Trademark: 911.NET

Petitioner

Registration No. 2551269

V.

Cancellation No. 92040559

Intrado Inc.

Registrant

United States Patent and Trademark Office
Trademark Trial and Appeal Board

Registrant's Brief in Opposition to Cancellation of Registration No. 2551269

I. Introduction

For the reasons set forth herein, petitioner fails to prove its case to cancel Registration No. 2551269 for "911.NET."

1. Irrespective of petitioner's claim of prior rights in the mark 911.NET, registrant's incontestable Registration No. 2204802 for 9-1-1 NET preempts petitioner's claim of rights.

2. Petitioner:

BOX TTAB

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- (a) has failed to meet its burden of demonstrating prior use of 911.NET,
- (b) has not made trademark usage of its 911.NET mark, and
- (c) has not made any interstate use of its mark.

3. Finally, removal of the registration sought to be cancelled herein will not afford petitioner the ability to register its mark (Serial No. 78/078405) because registrant's incontestable registration for the 9-1-1 NET mark anticipates it.

Please note that the Board required petitioner to

indicate whether it wishes the Board to consider this brief (in which case petitioner does not need to file another brief), or file a new brief that will serve as its main trial brief (in which case the brief filed on August 8, 2003 will not be considered).

Board order dated September 9, 2003. Petitioner has not done either, and therefore registrant responds to the only brief filed by petitioner, namely the August 8, 2003 brief.

II. Background

Registrant is in the business of providing computer hardware and software solutions to the emergency information network and is presently the largest nationwide company providing these services. When a "911" call is made by a person from a land line, a wireless connection, satellite, Voice over IP, or behind a corporate PBX, the telephone network queries registrant's computer systems, for information needed to route the call to the correct emergency response agency in the caller's geographic location. As you can well imagine, there is a substantial infrastructure to support this fail safe, emergency communication system, in addition to many user enabled capabilities. One such capability are the services provided by registrant, distinguished by its 911.NET and 9-1-1 NET marks, consisting of the necessary communication services to permit administration of these systems by subscribers, telecommunications providers and emergency administration personnel, to name a few.

Besides Registration No. 2551269 that is the subject of this action, Registrant is also the owner of the incontestable registered mark 9-1-1 NET (Principal Registration No.

2204802, a copy of which was submitted with Registrant's Notice of Reliance dated June 22, 2004). Registrant began its use of the 9-1-1 NET mark covering, *inter alia*, communication services directed at the emergency information network, as early as June 11, 1996. Registrant filed a combined affidavit of continuing use and incontestability under Sections 8 & 15 of the Lanham Act on November 25, 2003, which was accepted and acknowledged on February 18, 2004. Accordingly, registrant's 9-1-1 NET mark is incontestable.

In the twenty-five years of registrant's business, it has continually added new and additional features to its product/service offerings, while constantly keeping up with changes in technology, including the pervasive use of wireless communications and the Internet, as well as the many regulatory changes that have occurred (e.g., the Telecommunications Act of 1996 being the most noteworthy). Registrant's rapid response to changes in both technology and regulations has made it an industry leader.

Registrant commenced use of its mark 911.NET (subject of this action) as an extension of its 9-1-1 NET product offering. Registrant's 911.NET offering was in product development since late 1999 and first deployed as early as October 15, 2001, and has been used continuously since that date in interstate commerce. As discussed herein, petitioner has made limited non-commercial, non-trademark use of its 911.NET mark, and all such use has been intrastate and not interstate.

III. Argument

A. Petitioner's Claims of Prior Use are Not Substantiated by the Evidence.

Petitioner does not submit a single shred of valid evidence supporting its claim of prior use of the mark 911.NET. A review of the evidence illustrates this point.

i) Mere Registration Of The Domain Name 911.NET Is Not Trademark Use.

"Petitioner conceived of and registered the domain name for the trademark 911.NET in 1996 in connection with its Internet-based information security services."

Petitioner's brief page 1. Registration of a domain name used only to indicate an address on the internet is a domain name that is not functioning as a trademark. Lock heal Martin Corp, von Network Solutions, Inc. 985 F. Supp. 949, 956 (D.C. Cal. 1997); See also Trademark Office

Examination Guide No. 2-99, September 29, 1999. "Courts overwhelmingly agree that mere registration [of a domain name] is insufficient to support a claim of trademark dilution, just as it is inadequate to show infringement." Ford Motor Co. v. Grantdomnins.com, Inc. 177

F. Supp. 2d 635, 648 (E.D. Mi, 2001) citing, Panaxision Int'l, L.P. v. Toeppen, 945 F. Supp. 1296, 1303 (D.C. Ca. 1996). "[T]he mere registration of a domain name, without more, is not a "commercial use" of a trademark." Javas for Jesus v. Bradsky, 993 F. Supp. 282, 307 (D.N. J. 1998).

Petitioner has submitted no evidence showing its use of the domain name 911.NET as a trademark, but rather simply relies on its registration of the domain name. Petitioner's claim of prior use of 911.NET as a trademark by virtue of the registration of the domain name, flies in the face of accepted law pertaining to trademark usage cited above.

ii) <u>Use Of A Proposed Mark In A Final Grant Report Is Not Trademark Use.</u>

"... [I]n 1996 and 1997, Petitioner began using its 911.NET mark in commerce by developing its use in various business and marketing plans as well as using it in support of applications for state and federal grants." *Petitioner's brief page 1.* In support of its claim, petitioner "described the development of 911.NET as one of the commercial application plans for utilizing its directory service technology." *Petitioner's brief page 2. See also, E xhibit A to Petitioner's brief, 9th Page.*

The Lanham Act provides "the term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be used in commerce— (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services." 15 U.S.C. §1127. See also, TMEP Chapter 900. For registration purposes, the use of a service mark must show the mark in a manner that would be perceived by a potential purchaser as identifying the applicant's services and indicating their source. See, TMEP §1301.04. The specific evidence submitted by petitioner states:

Odyssi is likely to be a free service, funded by advertising, revenue from our directory products, and fees from the Wings' service. Consider it a major, sustainable market channel, assuring the success of our customers' directories, (including our own Wings). 911.net, Grandedir.com, LifeDate.com, Zombi.com, and GenomeNet.com are other directories we are developing to manage information for these communities: emergency medical services, residential listings, health care, teenagers and the humane genome research communities.

Exhibit A to Petitioner's brief, 9th Page. This use of '911.net' in a final grant report cannot remotely be considered a trademark usage of a proposed mark. Here, none of the predicates stated in the above definition are satisfied by the evidence, namely: i) a "bona fide use of a mark in the ordinary course of trade"; ii) "used or displayed in the sale or advertising of services"; iii) used in interstate or foreign commerce; and, iv) the "person rendering the services is engaged in commerce in connection with the services."

It is clear from the context cited above that this is a proposed use for a service directed at the "emergency medical service" industry, a field that is related to registrant's 911.NET mark (subject of this action) and registrant's 9-1-1 NET incontestable registration.

In its evidence, petitioner is explaining proposed uses of various domain names directed to particular industry groups. "Petitioner described the development of 911.NET as one of the commercial application <u>plans</u> for utilizing its directory service technology." *Petitioner's brief*, 2nd *Page (emphasis added.)*. Here again, petitioner is highlighting the fact it had plans to use 911.NET, as distinguished from actual use, i.e., using or displaying the mark "in the sale or advertising of services" in which "the person rendering the services is engaged in commerce in connection with the services." Marketing strategies and plans are insufficient to overcome an abandonment claim. *See, Emmpresa Cubana Del Tabaco v. Culbro Corp.*, 213 F. Supp. 2d 247 (S.D.N.Y. 2002). The foregoing proposed uses of 911.NET by petitioner are not trademark uses at all, and accordingly petitioner's cited use of 911.net in a state grant report can not support its claim of prior use.

iii) Prospective Business Discussions Of A Proposed Mark Is Not Trademark Use.

Petitioner attempts to draw the inference that because it had discussions with a prospective company to become a distributor of 911.NET brand products and services, that this too is a valid trademark use. See, Petitioner's brief, 2^{nd} page. Not only is this assertion misplaced, the conclusion drawn is not supported by the evidence.

Can we setup a time to review the home security material you have to see how the Internet features we are developing would fit with the vendor you have selected?

Would it work to develop the 911.net brand for "personal network security" and then we come in later with secure document delivery and safe info storage?

It gets us off the ground.

Exhibit B to Petitioner's brief, eMail from Petitioner to Al Eaton of Great Lakes Comnet. The unmistakable conclusion to be drawn from the foregoing is that petitioner is developing a product, that it is not yet using the mark and confirms in its brief, that these efforts never

came to fruition. See, Petitioner's brief, 2^{nl} page, Again, such preparations to use a mark do not satisfy the "use in commerce" requirements of 15 U.S.C. §1127.

iv) Without More, Use Of A Proposed Mark On An Invoice Is Not Trademark Use.

Petitioner attempts to demonstrate use of the mark 911.NET by the placement of the mark on two different invoices. *See, Exhibits C & D to Petitioner's brief.* There is no other evidence supporting petitioner's claim that it had an established business or trade in commerce to deliver either "(Services provided through 911.net Network Security Services)" as shown in Exhibit C, or "911.net Secure Networking Services an A.J. Boggs Company" as shown in Exhibit D. Noteworthy are the differences of the "remit to:" portions of each of these invoices.

Exhibit C: Invoice Number 10709 dated April 17, 2001, states: "Remit to 911.net Network Security Svcs, 4265 Okemos Rd., Suite D Okemos, MI 48864" yet, the payment was made to A.J. Boggs & Co. as shown in Exhibit 2 to the Confidential Deposition of Albert H. Eaton dated February 18, 2003 submitted by petitioner with the Stipulation filed with the Board January 23, 2004.

Exhibit D: Invoice Number 10554, dated October 23, 2000, states "Remit: A.J. Boggs & Company (911.net Network Security Services) 2853 W. Jolly Rd., Okemos, MI 48864."

The Exhibit D invoice states on its letterhead "911.net Secure Networking Services an A.J. Boggs Company", while the invoice a half year later (*Exhibit C*) shows the billing company as A.J. Boggs & Company. These are wide disparities of usage that are not support with a single additional piece of evidence in the record. Accordingly, one is left to the

unmistakable conclusion that these inconsistencies exist only because there are two invoices attempting to show a commercial use of the "911.net" mark¹.

It has long been held that use of a mark on an invoice which was inserted in a package with goods was not a "use" in commerce under the Lanham Act, and thus the mark was not registerable. *In re Chiango Rawhide Mfg. Co.*, 455 F.2d 563, (CCPA 1972). See also TMEP §§904.05 & 1301.04(a). Furthermore, as can be seen in Exhibit D, the invoice is on apparent letterhead "911.net Secure Networking Services an A.J. Boggs Company." Here, petitioner has not substantiated its invoices demonstrating that it actively advertised a 911.NET brand of service or that there is any association between "911.NET" and the services listed in the invoice. See, TMEP §1301.04(c). Therefore, petitioner failed to establish that the appearance of "911.net" on these invoices is a valid trademark use.

The Supreme Court teaches us "[t]here is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.... [T]he right to a particular mark grows out of its use, not its mere adoption." *United Drug Co. v. Theodore Rectanus, Co., 248 U.S. 90, 97, 39 S.Ct. 48, 63 L.Ed. 141 (1918)*. Accordingly, a mark is only considered to have been used in commerce if it accompanies services rendered in commerce such that the mark is employed in an established business or trade. None of the evidence submitted by petitioner comes close to meeting these essential requirements. Furthermore, each and every one of the specimens of evidence submitted is entirely within the State of Michigan, i.e., not in interstate or foreign

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¹ It is also noteworthy that petitioner's earlier attempts at showing use of the mark were directed at a directory service technology for the emergency medical services industry (a class 44 service) and then in October 2000, 911.net was billed as a service related to secure networking (a class 38 service). Indeed, by its own evidence, petitioner has switched the focus of its proposed service offering and accordingly it would necessarily have to claim different dates of first use and first use in commerce for the differing class coverage. *Sæ* 37 *C.F.R.* §2.86.

commerce. As the foregoing demonstrates, petitioner has not satisfied the "use in commerce" requirements of 15 U.S.C. §1127 to establish priority of right in 911.NET.

B. Registrant's Incontestable Registration No. 2204802 is a Bar to Petitioner's Mark.

Registrant is also the owner of Registration No. 2204802 for "9-1-1 NET" which is attached to registrant's Notice of Reliance dated June 22, 2004. That registration is not the subject of this action. Petitioner seeks to cancel registrant's Registration No. 2551269 because it anticipates petitioner's application Serial No. 78/078405 as stated by the Examining Attorney in the Office Action dated January 16, 2002. See Registrant's Notice of Reliance dated June 22, 2004 attaching the file unapper for Serial No. 78/078405. Conspicuously absent from petitioner's arguments is that registrant's Registration No. 2204802 for "9-1-1 NET" is also cited in anticipation of petitioner's application, yet petitioner seeks cancellation of only one of Registrant's two registrations. Furthermore, in the Notice of Suspension dated November 7, 2002, the Examining Attorney stated: "Refusal under Section 2(d) in view of Registration No. 2204802 is maintained." File unapper for Serial No. 78/078405, Page 2 of January 16, 2002 Office Action (emphasis in original).

Having satisfied the incontestable requirements of 15 U.S.C. §1065, Registration No. 2204802 is conclusive evidence of registrant's exclusive right to use the registered mark in commerce in connection with the services specified in the affidavit filed under the provisions of section 1065. See, Union Carbide Corp. v. Ewr-Ready Inc. 531 F.2d 366, (7th Cir. 1976). The Lanham Act provides only several limited defenses or defects which can be used to attack the validity of an incontestable mark, none of which are the subject of the present action. The mark "911.NET" falls within the penumbra of protection afforded to registrant by its incontestable right to use "9-1-1 NET." The "related goods doctrine" also known as

the "Aunt Jemima" rule teach us that the protection afforded a trademark is not limited to goods specified in the registration, but goes to any goods which are likely to cause confusion in the public's mind. See, Fleisdmann Distilling Corp. v. Manier, 314 F.2d 149, 151 (9th Cir.), cert. denied, 374 U.S. 830, 83 S.Ct. 1870, 10 L.E.d.2d 1053 (1963); Aunt Jemima Mills Co. v. Rigney & Co., 247 F. 407 (2d Cir.1917), cert. denied, 245 U.S. 672, 38 S.Ct. 222, 62 L.E.d. 540 (1918).

Similarly, registrant has two registrations for interrelated services for virtually identical marks except for the deletion of two hyphens, and the addition of a period. Registrant's adoption and use of "911.NET" is a mere extension of the established rights in the incontestable "9-1-1 NET" registration.

Petitioner asserts purported prior use of 911.NET is grounds for canceling registrant's registration. However, they are mistaken since registrant's 9-1-1 NET mark is an incontestable federal registration which may not be challenged upon the basis that the mark is inferior in priority to petitioner's claim of acquired rights. *See, Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc., 841 F. Supp. 1339, 1352 (E.D.N.Y. 1994).* Rather, the incontestability provisions of the Lanham Act create a conclusive presumption of validity of a registered mark, in effect providing a means for the registrant to quiet title in the ownership of its mark and encouraging producers to cultivate the good will associated with a particular mark. *See, Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 198, 83 L. Ed. 2d 582, 105 S. Ct. 658, 663, 224 U.S.P.Q. 327, 331 (1985).* Accordingly, registrant's incontestable registration anticipates any proposed or actual use of petitioner's 911.NET mark. Should petitioner prevail in its assertion, the result would be a likelihood of confusion in both the marketplace and on the register. Since that would not be sanctioned under the Lanham Act, petitioner's argument is without merit.

For the reasons set forth above, registrant respectfully requests that the Board deny petitioner's complaint and maintain Registration No. 2551269 on the registry.

Respectfully submitted: GORDON E. R. TROY, PC

/Gordon E. R. Troy/

3y:____

Gordon E. R. Troy

Attorney for Defendant/Registrant

Please note that the address for the registrant/defendant is incorrectly listed in the TTAB as:

INTRADO, INC. 2325 LAKEVIEW PARKWAY SUITE 700 ALPHARETTA, GA 30004

The Correct address for registrant/defendant is:

INTRADO, INC. 1601 Dry Creek Drive Longmont, CO 80503

Certificate of Service

The undersigned hereby certifies that a copy of the foregoing **Registrant's Brief in**Opposition to Cancellation of Registration No. 2551269 along with Confirmation

Receipt from TTAB ESTTA system has been served on counsel for petitioner/plaintiff

by depositing same with the United States Postal Service with sufficient postage as first-class

mail in an envelope addressed to:

Jeffrey A. Sadowski, Esq. Howard & Howard Attorneys, PC 39400 Woodward Avenue, Suite 101 Bloomfield Hills, MI 48304

On October 1, 2004.

Respectfully submitted: GORDON E. R. TROY, PC

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By:_

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